

### **Remarks**

This application has been carefully reviewed in light of the Office Action mailed March 7, 2006. At the time of the Office Action, claims 1-20 were pending in this application. In the Office Action, the Examiner rejected claims 1-20. By this amendment, Applicant has amended claim 7 and has added claim 21 to clarify the subject matter which Applicant claims as the invention and to advance prosecution of this application. No new matter has been introduced by these amendments. Applicant does not admit that these amendments were necessary as a result of any cited art. Applicant respectfully requests reconsideration of the above application in view of the following remarks.

#### **Objection to Claim 7**

Claim 7 stands rejected as including a limitation, i.e. "the battery," which lacks antecedent basis. Applicant amends claim 7 to recite "the power for the battery powered circuit." As such, Applicant requests the Examiner to withdraw this objection.

#### **Rejection Of Claims 1-12 Under 35 U.S.C. § 103(a) As Being Unpatentable Over Chien In View Of Sekura**

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chien* (U.S. Patent No. 6,158,868) in view of *Sekura* (U.S. Patent No. 6,198,383). Applicant respectfully traverses this rejection because (1) the proposed combination does not teach, disclose or suggest the pending claims and (2) the references are not properly combinable.

The proposed combination does not teach, disclose or suggest the claimed invention. For instance, the proposed combination does not provide "one or more alternating current (AC) powered lights configured as a back light to the LCD", as recited in independent claims 1 and 11. At best, *Chien* includes an electro-luminescent clock face that illuminates itself. Claims 1 and 11 require, *inter alia*, two elements: (1) an LCD and (2) a back light to the LCD. *Chien* provides neither.

*Chien* provides an “electro-luminescent element may be supplied not only through the prongs but, optionally, through components such as an inverter or another power source such as at least one additional battery for providing power in the event of a power failure, a smoke detector, a flood detector, an earthquake detector, and an animal detector[.]” (col. 4, ll. 25-31). “[T]he numbers of the clock face are printed, painted, or otherwise formed on the electro-luminescent element itself, although it will be appreciated by those skilled in the art that the numbers could also be printed, painted, or otherwise formed on the protective member 20, and that other designs or messages could also be formed either on the electro-luminescent element or the protective member 20 and cover. Preferably, except for any designs formed thereon, protective member 20 is transparent to permit light from the electro-luminescent element to be visible.” (col. 4, ll. 61-67).

*Sekura* does not cure the deficient teachings of *Chien*. According to the Examiner, *Sekura* discloses a battery powered clock with an LCD display and a driver circuit for the LCD display and to keep time. The *Sekura* reference does not teach, disclose or suggest a back light for the LCD. The Examiner has not provided a teaching from *Sekura* to indicate otherwise. For at least this reason, claim 1 (and depending claims 2-10 and 21) and claim 11 (and depending claim 12) are patentable over the proposed combination and the other cited art.

Moreover, there is no suggestion or motivation to combine the cited references. As stated in the MPEP, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01, 8<sup>th</sup> ed., Rev. 3. The proposed combination is clearly undesirable. The Examiner attempts to add the LCD of *Sekura* to the electro-luminescent clock face of *Chien*, thereby proposing a combination with two clock displays. In doing so, the structural location of the electro-luminescent clock face must be moved from a display position to behind the LCD of *Sekura*, thereby hiding the clock face so that it is inoperable for its intended purpose, *i.e.* displaying the time.

The Examiner agrees that *Chien* teaches away from the use of LCD displays. This is yet another basis for the impropriety of the Examiner's combination. The Examiner addresses this by stating that *Chien's* "arguments are not all inclusive". (Office Action, March 7, 2006, p. 3). The Examiner then impermissibly engages in hindsight guided by the Applicant's claims that "a person in the art would recognize the limitation of *Chien's* arguments and design, with regard to LCD displays" to provide the claimed invention. The Examiner has not provided any evidentiary support in the record for this recognition, instead inappropriately relying on common knowledge. MPEP § 2144.03, 8<sup>th</sup> ed., Rev. 3 ("It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based."). For at least this reason, claim 1 (and depending claims 2-10 and 21) and claim 11 (and depending claim 12) are patentable over the proposed combination and the other cited art.

Claims 2-10 and 21, which depend from claim 1, and claim 12, which depends from claim 11, are patentable for the above reasons in addition to their own patentable limitations. For example, claim 21 recites that "the back light is situated behind the LCD". The proposed combination and the other art of record do not teach, disclose, or suggest this limitation. To the contrary, the *Chien* electro-luminescent clock face illuminates itself and the *Sekura* LCD is not back lit. For at least these reasons, Applicant respectfully request reconsideration and allowance of claims 1-12 and 21.

**Rejection Of Claims 13-14, 16-17 And 19-20 Under 35 U.S.C. § 103(a)  
As Being Unpatentable Over Chien In View Of Sekura In Further View Of Kibiloski**

Claims 13-14, 16-17 and 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chien* in view of *Sekura* and in further view of *Kibiloski* (U.S. Patent No. 6,987,710). Applicant respectfully traverses this rejection because (1) the proposed combination does not teach, disclose or suggest the pending claims and (2) the references are not properly combinable.

The proposed combination does not teach, disclose or suggest the claimed invention. For instance, the proposed combination does not provide “an alternating current (AC) powered lights back light to the LCD”, as recited in independent claim 13. At best, *Chien* includes an electro-luminescent clock face that illuminates itself. Claim 13 requires, *inter alia*, two elements: (1) an LCD and (2) a back light to the LCD. *Chien* provides neither. Neither *Sekura* nor *Kibiloski* cures the deficient teachings of *Chien* because neither reference teaches, discloses or suggests a back light for the LCD. The Examiner has not provided a teaching from *Sekura* nor *Kibiloski* to indicate otherwise. For at least this reason, claim 13 (and depending claims 14, 16-17 and 19-20) are patentable over the proposed combination and the other cited art.

Moreover, there is no suggestion or motivation to combine the cited references. Applicant relies on its remarks above for the impropriety of combining *Chien* with *Sekura*. Furthermore, it is not proper to combine *Kibiloski* with *Chien* and *Sekura*. At best, *Kibiloski* provides a transparent dial face that overlies a reflector. (col. 5, ll. 23-27.) (“Dial 35 is in front of, and generally overlies the reflector 40. For good light transmission therethrough, dial 35 is generally transparent, except for the generally opaque time-indicating numerals 36 and other indicia[.]”) The Examiner cites to a passage from *Kibiloski* providing that “[a] light illumination module, such as a light emitting diode (LED), in combination with a light reflector, is disposed ... behind ... the clock dial[.]” There is no suggestion of the desirability of combining *Kibiloski*, which includes an LED light behind a transparent dial face, with *Chien* or *Sekura*, which do not provide a back lights. The Examiner opines that it would have been obvious “to modify *Chien*’s [electro-luminescent] light [with *Kibiloski*’s teachings] in a way that it would function both as a back light ... and as [a] night light”. (Office Action, March 7, 2006, p. 7). The Examiner’s own statements belie this suggested modification. On page 2 of the Office Action, the Examiner states that “[w]hile *Chien* provides a light for the purpose of lighting a room the same light inherently lights the time display such that it can be read.” If the *Chien* light is necessarily a back light for lighting the display, then the Examiner’s suggested modification with the teachings of *Kibiloski* is completely unnecessary, and is fundamentally flawed. Moreover, to the extent that the Examiner relies on common knowledge

to support this obviousness rejection, Applicant requests the Examiner to provide evidence from the record in support of this common knowledge, as required by MPEP § 2144.03. For at least these reasons, claim 13 (and depending claims 14, 16-17 and 19-20) are patentable over the proposed combination and the other cited art.

***Rejection Of Claim 18 Under 35 U.S.C. § 103(a)  
As Being Unpatentable Over Chien In View Of Sekura  
In Further View Of Kibiloski And Yet In Further View Of Article***

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chien* in view of *Sedura* in view of *Kibiloski* and yet further of an article found at [members.misty.com/don/oddbulb.html](http://members.misty.com/don/oddbulb.html) (“Article”). Claim 18 depends from claim 13, which Applicant has shown to be allowable, and claim 18 is allowable for at least this reason. In addition, claim 18 recites further patentable distinctions over the references of record. However, to avoid burdening the record and in view of the clear allowability of claim 13, Applicant does not specifically address these reasons in this Response. Applicant reserves the right to present these reasons in a future response if appropriate.

***Rejection Pf Claim 15 Under 35 U.S.C. § 103(a) As  
Being Unpatentable Over Chien On View Of Sekura In View  
Of Kibiloski And Yet In Further View Of RTP Articles***

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chien* in view of *Sekura* in view of *Kibiloski* and yet in further view of data sheets found at [rtpcompany.com/info/data](http://rtpcompany.com/info/data) (the RTP Articles”). Claim 15 depends from claim 13, which Applicant has shown to be allowable, and claim 15 is allowable for at least this reason. In addition, claim 15 recites further patentable distinctions over the reference of record. However, to avoid burdening the record and in view of the clear allowability of claim 13, Applicant does not specifically address these reasons in this Response. Applicant reserves the right to present these reasons in a future response if appropriate.

### Conclusion

For the foregoing reasons, Applicant believes that the Office Action of March 7, 2006 has been fully responded to. Consequently, in view of the above amendments and remarks, Applicant respectfully submits that the application is in condition for allowance, which allowance is respectfully requested.

The \$25.00 fee for the presentation of one additional dependent claim and \$60.00 one-month extension fee, and any additional fees or credits, should be applied to Deposit Account 02-3978. A duplicate copy of this paper is enclosed for that purpose.

If the Examiner feels that a telephonic conference would advance prosecution of this application in any manner, the Examiner is invited to contact Matthew M. Jakubowski, attorney for Applicant at the Examiner's convenience at (248) 358-4400.

Respectfully submitted,

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